80-141

No.

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In the

Supreme Court of the United States

OCTOBER TERM, 1979

Kelley Manufacturing Company,

Petitioner,

vs.

Lilliston Corporation,

Respondent.

On Writ of Certeriori to the United States Court of Appeals for the Fourth Circuit.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

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The Scheffer Press. Inc.—(312) 263-6850

QUESTIONS PRESENTED

1. Whether the decision below is contrary to the federal patent policy of *Lear* v. *Adkins,* 395 U.S. 653 (1969), militating against invalid patents and their anti-competitive effects, in that the Court below failed to afford to the public the intervening rights guaranteed by statute (35 U.S.C. §252) against a reissue patent, reissued because its original patent was invalid.

2. Whether the absolute intervening right guaranteed to the public by the first sentence of the second paragraph of 35 U.S.C. §252 will be upheld where the original patent was invalid as barred under 35 U.S.C. §102(b), regardless of whether the crucial claims of the reissued patent were in the original patent.

3. Whether the Court of Appeals neglected its judicial function in summarily affirming the trial Court's misapplication of the obviousness test of *Graham* v. *John Deere & Co.,* 383 U.S. 1, 17 (1966), in holding non-obvious a patent to a farm implement, where the claimed combination of old elements is plainly taught in a simple combination of prior art patents. *Great A & P Tea Co.* v. *Supermarket Corp.,* 340 U.S. 147, 152 (1950); *Sakraida* v. *Ag Pro, Inc.,* 425 U.S. 273, 282 (1976).

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1979

No.

Kelley Manufacturing Company,

Petitioner,

vs.

Lilliston Corporation,

Respondent.

On Writ of Certeriori to the United States Court of Appeals for the Fourth Circuit.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

Petitioner respectfully prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Fourth Circuit in this case.

OPINIONS BELOW

The opinion of the District Court was reported unofficially at 200 U.S.P.Q. 670 (E.D.N.C. 1978). The opinion of the Fourth Circuit Court of Appeals was designated* for non-publication. Both opinions are reproduced in the Appendix, *infra* at A1 and A33, respectively.

JURISDICTION

The Appeals Court entered judgment on February 28, 1980. A timely petition for rehearing, filed March 13, 1980, was denied by order of April 28, 1980.

This Court has jurisdiction under 28 U.S.C. §1254(1).

THE STATUTES INVOLVED[1]

1. Non-obviousness and Validity.

35 U.S.C. §103:

"§103. *Conditions for patentability; non-obvious subject matter*

A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

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* However, this opinion was cited and quoted from at 479 BNA PTC) A-4 (May 15, 1980), and Petitioner has moved for publication of the opinion.

[1] Complete texts of the following and of additional authorities cited in this Petition, Constitution Art. I §8; 35 U.S.C. §§102 (b), 120, and 254; and 37 C.F.R. §1.175 (a) (4), are set forth at App. A37.

2. Reissue Application.

35 U.S.C. §§251 and 252:

"§251. *Reissue of defective patents*

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, . . . the Commissioner shall, on the surrender of such patent . . ., reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent."

"§252. *Effect of reissue*

* * *

No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. . . ."

STATEMENT OF THE CASE

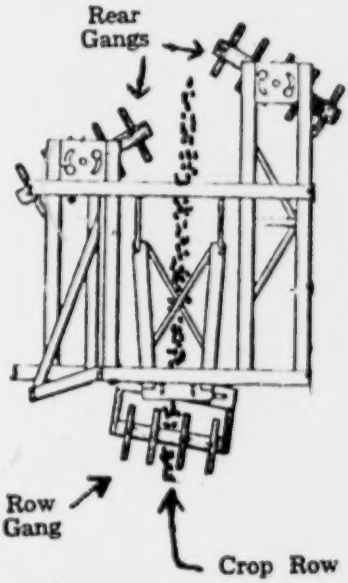
The Suit and Issues Below

Petitioner Kelley Manufacturing Company (Kelley) filed a declaratory judgment action in the trial Court on September 19, 1972, seeking *inter alia* declarations of invalidity and non-infringement of United States Patent No. 2,994,387 (the '387 patent), issued to Lehman *et al* and assigned to the Respondent, Lilliston Corporation (Lilliston). Jurisdiction was founded on 28 U.S.C. §2201. Lilliston counterclaimed for patent infringement.

The '387 patent was succeeded by Reissue Patent No. 28,271 (the '271 Reissue Patent), on December 10, 1974. An amended complaint was filed, raising also intervening rights issues. The '271 Reissue Patent expired on July 31, 1978.

The Subject Matter of the Patent In Suit

The '271 Reissue Patent (Supplemental App. SA 1) relates to a farm implement. The implement claimed includes a cultivator comprising a pair of rear gangs of rotary hoes[2] which cultivate soil on either side of a crop row. Combined with the rear gangs is a single front gang of rotary hoes which rides atop the crop row. It is the triangular configuration of the front "row gang" and the "pair of rear gangs" which were claimed to be patentably novel and non-obvious (S. App. SA 18-19 (Claim 20), App. A8).



Kelley has made and sold a similar, but not identical, cultivator since September 1971. No review of the infringement issue is sought here.

The Prior Art

The patent art on farm machines is crowded and highly developed, as was recognized in both Courts below (App.

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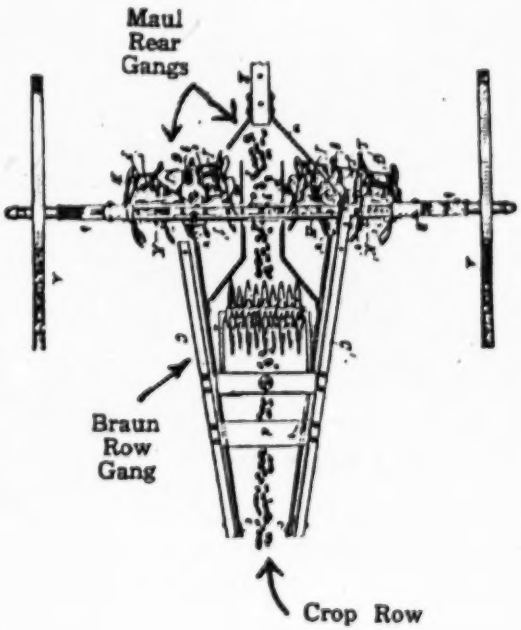
[2] A "rotary hoe" is a wheel or drum of protruding blades or tines. A "gang of rotary hoes" is a grouping of multiple rotary hoes in a single axle. (App. A4, S. App. SA7, 12 lines 19-20 Fig. 13).

A10 and A34). Prominent here are U.S. Patent No. 529,457 issued on November 20, 1894, to C. Maul (S. App. SA18) and U.S. Patent No. 1,908,110 issued on May 9, 1933, to O. Braun (S. App. SA24). Both these patents were relied upon before the trial and Appeals Courts.

The Maul Patent of 1894 shows the now conventional and now un-patentable farm implement having a pair of rear gangs of rotary hoes which cultivate on either side of a crop row, exactly as shown and claimed in the '271 Reissue Patent. It is not disputed that Maul also provided every adjustment for the rear gangs of rotary hoes—up, down, angling, and tilt—as is disclosed and claimed for the pair of rear gangs of the '271 Reissue Patent. So, the rear portion of the '271 Reissue Patent is unpatentably ancient and was "conventional" in 1933.

The Braun Patent of 1933 discloses "a rotary hoe attachment for conventional cultivators used for row crops" (S. App. SA 25 lines 2-4). Braun expressly teaches adding to the standard, conventional farm cultivator implement a single front gang of rotary hoes which rides up and down along and atop the crop row. Any patentable nonobviousness in a triangular configuration of soil cultivator tools was exhausted by Braun in 1933.



The Prior Sale Invalidity and Reissuance

The '387 patent originally in suit claimed on its face, pursuant to 35 U.S.C. §120, to be derived in part from prior patent applications dating to as early as March 18, 1959. In regard to that fact the trial Court found, in its opinion of June 2, 1978, that:

> "The Lehmans sold a cultivator embodying features covered by this patent to a Mr. Eugene Engels 'around the first of March' of 1958",

and concluded:

> . . . "it may very well be that there was a sale of the patented invention more than one year prior to March 18, 1959. . . . If so, the ['387] patent would be invalid under 35 U.S.C. §102(b)". App. at A6-7

The "if so" was fulfilled, so the original '387 patent was invalid as stated.

The facts of the prior sale invalidity were actually known to Lilliston as early as 1962. But it was not until after the "on sale" invalidity was pleaded in this suit that Lilliston sought to cure the invalidity. Its first effort to obtain a claim to priority of April 1, 1958, was via Patent Office certificate of correction (35 U.S.C. §254) (App. A42). Its petition was rejected by the Patent Office Solicitor in view of the need to protect "statutory intervening rights" afforded only by the reissue process against such a change in claim (App. A43). Lilliston did apply for a reissue patent, on September 21, 1973. The '271 Reissue Patent was granted on December 10, 1974.

The Rulings Below

A. On Intervening Rights

The trial Court's opinion never addressed or acknowledged Kelley's intervening rights defense, although there is no question that the issue was pleaded, tried, and briefed. The facts recited in the published opinion plainly raise an intervening rights issue.

The Appeals Court sought to convert that error of neglect into an affirmative act of denial by the trial Court. The Appeals Court ruled mistakenly that:

1. "A court, in its discretion, may recognize the 'intervening rights' of an infringer under the traditional, equitable doctrine now codified in Section 252 of Title 35 of the United States Code" (App. A35);
2. The intervening rights doctrine ". . . has no application where the crucial claims of the reissued patent are substantially identical to those of the original patent, 35 U.S.C. §252 . . ." (App. A36); and
3. The contention ". . . that the change in priority date constitutes the requisite change in the claims of the patent to justify . . . assertion of intervening rights" is without merit (App. A36n).

B. On Validity

On the validity/obviousness issue, the trial Court in its written memorandum discussed the patent to Maul, but did not discuss the pertinent, specific teaching of Braun (App. A10). The trial Court compounded that factual error by reformulating the obviousness test of *Graham* v. *John Deere & Co.* (*supra,* 383 U.S. at 17) into an erroneous test of "was the inventor the

first to combine the old elements"? Specifically the trial Court ruled:

> "The conclusion is that although the scope and content of the prior art encompassed all the elements found in the patent in suit, . . . the Lehmans were the first to combine the old elements in a way that produced a new, beneficial and unexpected result. It follows that the invention is not void for obviousness." (App. A11-12).

The Appeals Court did not discuss either the trial Court's clear error of fact in ignoring the Braun teaching or the trial Court's clear error of law in revising the obviousness test mandated in *Graham* v. *Deere*. The Court of Appeals neglected its judicial function in so failing to give due or express consideration to the errors alleged in the trial Court's decision.

REASONS FOR GRANTING THE WRIT

Review and Reversal to Confirm Absolute Intervening Rights Will Affirm the Federal Patent Policy that the Public is Not To Be Burdened by Invalid Patents

This Court has never reviewed the intervening rights sections of the 1952 Patent Statute. Its last examination of the developing intervening rights doctrine was forty years ago, in *Sontag Stores Co.* v. *Nut Co.,* 310 U.S. 281 (1940), when solely equitable principles prevailed.

Intervening rights are a statutory extension of the federal patent policy protecting the public against the burdens of invalid, defective patents. Under that policy, known inventions and developments which are not protected by a *valid* patent are, as they were meant to be, available to the public for its free use. *Lear, Inc.* v. *Adkins,* 395 U.S. 653, 668 (1969) (emphasis added); *Sears, Roebuck* v. *Stiffel Co.,* 376 U.S. 225, 230-1 (1964); *Compco Corp.* v. *Day-Brite Lighting Inc.,* 376 U.S. 234, 237 (1964). That policy is deeply rooted in the history of this country.

The constitutional mandate, Article 1 Section 8, authorizing patent rights was controversial at its inception because it encroached upon the public's right to the free use of available knowledge. For that reason the patent laws are stringent and precise, and must be strictly observed and applied. *Sears, supra,* at 230.

A patent which is invalid in view of a prior sale or public use of the invention (35 U.S.C. §102(b)) is invalid as to each of its claims.[3] Even where that invalidity

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[3] *Timely Products Corp.* v. *Arron,* 523 F.2d 288, 302 (2d Cir. 1975).

arises (as here) out of a failure to claim the benefit of an earlier filing date which would avoid the §102(b) bar, the patent and its subject matter claims are nonetheless invalid.[4]

Some types of errors which render a patent "inoperative or invalid" are made correctable through the statutory mechanism of reissue under 35 U.S.C. §251. Patentees thus may validate patents prospectively to remove alleged grounds of invalidity, and that procedure in fact now is being encouraged.[5] But that statutory right to correct an invalid patent is balanced by statutory obligations set forth in 35 U.S.C. §252, entitled "Effect of Reissue".

The second paragraph of 35 U.S.C. §252 is "not entirely a codification of the [prior] case law . . . and should be considered on its own terms." Frederico, *Commentary on the New Patent Act,* 35 U.S.C.A. 1, 45-46 (1952). It has never been reviewed by this Court. The first sentence relates to the new doctrine of absolute intervening rights and the second sentence relates to the old doctrine of equitable intervening rights. The first sentence, which is of concern here, is a statutory extension of the federal patent policy in that it establishes

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[4] E.g., *Sticker Industrial Co.* v. *Blaw-Knox Co.,* 405 F.2d 90, 93 (7th Cir. 1968).

[5] Filing of reissue applications prior to or during litigation to obtain "expert" Patent and Trademark Office rulings on novelty and obviousness in view of previously uncited prior art and on other grounds of invalidity was made possible by a 1977 change in the rules (37 C.F.R. §1.175 (a) (4)). Reissue applications are being encouraged by the District Courts, e.g., *Sheller Globe Corp.* v. *Mobay Chemical Corp.,* ..... F.Supp. ....., 204 U.S.P.Q. 1052, 1055-56 (E.D. Mich. 1980).

an absolute intervening right to the public of free use of an invention prior to the grant of the reissue. The only exception to application of that absolute right arises if the ". . . thing infringes a valid claim of the reissued patent which was in the original patent."

Because the invalidity of the original '387 patent was based upon a statutory bar under 35 U.S.C. §102(b), all of its claims also were invalid. Accordingly it is important to give consideration to the language of the absolute intervening right statute. Did the invalidity of the '387 original patent under 35 U.S.C. §102(b) negate the applicability of the phrase ". . . unless the . . . thing infringes a valid claim of the reissued patent which was in the original patent"? Such question has not been reviewed by this Court. In this case below, the Appeals Court recognized that an equitable intervening right could arise, and thus apparently that the exception is not applicable. However, then misreading the statute, it denied the existence of the parallel absolute intervening right under the statute. That inexplicable error calls for review and correction here.

Review of the federal patent policy of *Lear* v. *Adkins* and its progeny as it relates to intervening rights is especially important at this time, since the reissue rules have been changed and the Patent Office practice has been popularized to allow expedient review and correction of allegedly deficient patents.[6] The strong federal policy

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[6] Patent Office records show that the number of applications for reissue patents increased from 219 in 1960, to 344 in 1970, to 465 in 1975, to 657 in 1979. United States Patent & Trademark Office, Commissioner's Annual Report—1979, pg. 29.

against burdening the public with originally invalid patents until such time as the defects are removed by the reissue process can and should be vindicated in this case. The facts here and the public policy effects of the statute make review here timely, necessary, and important.

Review Is Necessary To Establish Conformity Between 35 U.S.C. §252 and the Policy Of Strict Statutory Construction

The policy of strict statutory construction is one ordered by our constitutional form of government guaranteeing the separation of powers. This Court has repeatedly cautioned against judicial encroachment and has stated that the judicial branch is without choice to carry out the letter of the law as set forth by the legislative branch. A court may not at its discretion ignore or interpret a federal statute plainly written.[7]

Yet in this case, the trial Court ignored the pleaded protection of intervening rights. In the Appeals Court, the plain language of the statute was misread and the trial Court's error worsened. Review is required here to direct the Appeals Court below to give reasoned effect to the language of the intervening rights statute.

Review Will Resolve Actual Conflicts As To The Effect of A Reissue Changing A Claim to Validating Benefit of an Earlier Application Priority

A claim to benefit of priority of an earlier application (35 U.S.C. §120) may be changed through reissue pro-

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[7] *Washington Market Co.* v. *Hoffman,* 101 U.S. 112, 115-16 (1879); *Dawson Chemical Co.* v. *Rohm & Haas Co.,* 48 U.S.L.W. 4908, 4911 (June 27, 1980).

cedures to negate the invalidating effect of a prior public use or sale. That was done here. But the availability of reissue procedures should not change the fact that the original claims to invention were invalid in law prior to the change of claim to priority under the reissue statute. The several decisions which treat this narrow subject show actual conflict and divergence of approach in this important area.

The courts in each of *State of Israel* v. *Brenner*,[8] 400 F.2d 789, 791-92 (D.C. Cir. 1968); *Sticker Industrial Supply Co.* v. *Blaw-Knox Co.*,[9] 321 F.Supp. 876, 880 (N.D. Ill. 1970); *Fontijn* v. *Okamoto*,[10] 518 F.2d 610, 621 (C.C. P.A. 1975); and *Kelley Mfg. Co.* v. *Lilliston Corp.*,[11] below, No. 78-1700 (4th Cir. February 28, 1980) (App. A33, A36n), suggested or held that only equitable rights are available where a priority claim is changed to obtain a valid reissue patent. The court in *St. Regis Paper Co.* v. *Bemis Co.*, 403 F.Supp. 776, 791-93 (S.D. Ill. 1975), reversed on other grounds, 549 F.2d 833 (7th Cir. 1977), squarely held that granting a reissue patent changed solely to claim an earlier priority date validated the original patent with "no substantive change", so that no intervening rights (absolute or equitable) would arise under the statute, which "merely codified equitable prin-

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[8] "§252 can be read . . . to protect a *deserving* third party. . . ."

[9] ". . . intervening right, if any, may be relevant to the final adjudication of the *equities*."

[10] ". . . *equitable* interests of any party . . . are adequately protected by . . . §252 . . ."

[11] ". . . Section 252 could come into play to protect . . . *equitable* interests. . . ."

ciples devolved under the prior law."[12] Other courts have recognized that both absolute and equitable rights arise where no valid claim of the original patent is retained unchanged in the reissue patent: *Wayne-Gossard Corp.* v. *Moretz Hosiery Mills, Inc.*,[13] 539 F.2d 986, 989 (4th Cir. 1976) (narrowed reissue claims); *Plastic Container Corp.* v. *Continental Plastics*,[14] 607 F.2d 885, 901 n.35 (10th Cir. 1979) (reissue claims broadened to cover device).

Review is necessary to bring into focus the circumstances under which the absolute rights of the statute are to be applied; it would be definitively instructive to the trial courts in which increasing numbers of reissue patents are being litigated, to eliminate the confusion which cases such as *St. Regis* and this case has caused.

The Trial Court's Obviousness Test, Grossly In Conflict With Graham v. Deere, Should Have Been Reversed on Appeal

Finally, a writ of certiorari should issue to require that the Court of Appeals below perform its judicial

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[12] Contrast Frederico, *Commentary on the New Patent Act*, 35 U.S.C.A. 1, 45-46: "The second paragraph of section 252 is not entirely a codification of the case law . . . it varies in some respects . . . and should be considered on its own terms."

[13] The first sentence of §252, second paragraph, "granted an absolute right . . .", although no claim for pre-reissuance damages was pressed, and "under the second sentence . . . the court '*may* provide for the continued manufacture use or sale' of the article . . . ."

[14] "An infringer has the unqualified right to continue to use or sell those . . . goods . . . made . . . prior to the reissue grant. . . ."

function in this case. The *Graham* v. *John Deere* standards mandated by this Court must be effected in each and every patent case involving the obviousness question.[15] As shown *supra* at 7-8, although the District Court recognized the *Graham* test, it actually ignored the combination of Braun and Maul and applied instead a unique, unwarranted test of whether the Lehmans were the "first" to make the combination (App. A12). That is not the obviousness test mandated by this Court in *Graham*.

For the trial Court to have applied its own test was a clear error of law which should have been corrected by the Appeals Court. The Appeals Court's apparent failure to examine Kelley's specific objection and to correct the abrupt departure from the *Graham* mandate call for exercise of this Court's supervisory responsibility.

CONCLUSION

It has been more than 20 years since this Court's decision in *Lear* v. *Adkins*, and its emphasis therein of federal patent policy. It is timely, particularly in view of the currently increased use of the reissue statute, to review and affirm that policy specifically as promulgated in 35 U.S.C. §252, guaranteeing an absolute intervening right in reissue cases as against invalid original patents.

In reviewing the reissue statute it is important to consider whether its language may be used to frustrate a party's absolute rights where the original patent was

[15] *Sakraida* v. *Ag Pro*, 425 U.S. 273, 279 (1976).

invalid because of a statutory bar under 35 U.S.C. §102 (b), regardless of whether the infringed reissue claims to invention were otherwise identical to the original patent claims.

Finally, the *Graham* v. *Deere* test of patentable obviousness or not under 35 U.S.C. §103 must be adhered to by the lower courts. The trial Court's "first to combine" test, in abrupt conflict with the *Graham* test, should have been scrutinized and reversed upon appeal.

It is urged that review of the opinion and judgment of the Court of Appeals below is appropriate and necessary. This Petition should be granted.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that three (3) copies of the foregoing PETITION FOR WRIT OF CERTIORARI with APPENDIX and of the accompanying SUPPLEMENTAL APPENDIX have been served by mail on counsel for respondent, addressed as follows: William A. Marshall, Merriam, Marshall & Bicknell, Two First National Plaza, Chicago, Illinois 60603, this 28th day of July, 1980.

APPENDIX TO PETITION FOR WRIT OF CERTIORARI

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APPENDIX TO PETITION FOR WRIT OF CERTIORARI

IN THE UNITED STATES DISTRICT COURT
For The Eastern District Of North Carolina
Wilson Division

KELLEY MANUFACTURING COMPANY,

Plaintiff,

vs.

LILLISTON CORPORATION,

Defendant.

CIVIL NO. 1295
JUN 2, 1978
John R. Whitty, Clerk
U.S. District Court
E. Dist. No. Car.

MEMORANDUM OF DECISION

Following dismissal of an action for patent infringement brought by Lilliston Corporation (Lilliston), a Georgia corporation, against Kelley Manufacturing Company (Kelley), another Georgia corporation, in the Southern District of Texas on improper venue gorunds Kelley instituted this declaratory judgment action in the Eastern District of North Carolina where Lilliston maintains a warehouse and conducts some business. The First Claim of plaintiff's complaint was severed for trial purposes and has been tried to the court without a jury on the issues of validity, enforceability and infringement of a patent held by Lilliston for a farm cultivator.[1] In this

[1] Kelley's Second and Third Claims allege violations by Lilliston of the antitrust laws; the Fourth Claim alleges violations of the unfair competition laws of North Carolina and Georgia; and the Fifth Claim charges Lilliston with infringement of a peanut harvesting machine. These claims have been reserved for trial at a later date.

memorandum of decision the court will record its findings of fact and conclusions of law as required by Rule 52(a), F.R.Civ.P. Jurisdiction is based on 28 U.S.C. §§ 1338 and 2201.

The patent in suit is United States Reissue Patent No. 28,271 (the '271 Reissue Patent) entitled "Cultivator" which issued originally as United States Patent No. 2,994,387 (the '387 Patent) on August 1, 1961 to Charles L. and Alvin H. Lehman and by them assigned to Lilliston in 1961. Plaintiff's complaint which originally attacked the validity of the '387 patent was amended following its reissue on December 10, 1974, but the complaint as amended did not essentially depart from the typically all-inclusive allegations usually found in patent litigation, that is to say, it alleged that the reissue patent is invalid, void and unenforceable because of the prior use, sale and disclosure of the patented invention; anticipation by the prior art; obviousness in view of the prior art; abandonment; file wrapper estoppel; new matter; failure to obtain a license to file foreign applications; failure to clearly disclose, define or distinctly claim the invention; failure to set forth the best mode contemplated by the inventors for carrying out the invention; claiming aggregations of parts of elements; inoperative disclosure, incapable of accomplishing the intended purpose; inutility; indefinite and overbroad claims; bad faith; intentional and material representations to the Patent Office and estoppel by reason of the same; patent misuse; and violation of the antitrust laws.

In an amended answer defendant denied all of plaintiff's allegations and in a counterclaim alleged infringement by plaintiff of Claims Eight, Ten — Thirteen and Twenty — Twenty-Four inclusive of the '271 reissue patent. Relief sought by the defendant on its counterclaim includes a permanent injunction against infringement of the patent by Kelley; damages for past infringement; punitive and treble damages because of the alleged willful and deliberate nature of Kelley's infringement; and costs and attorney's fees.

The patent in suit relates to an apparatus for cultivating crops planted in parallel rows, and the general objective of the invention is

> ". . . To provide a rotary cultivator having separate gangs of 'free-floating' rotary hoes which will engage the row crops with a greater force than heretofore possible with cultivators having conventional free-floating gangs of hoes."

After listing some ten or more additional objects of the invention (see Appendix A attached hereto) the patent states that

> "These and other objects are accomplished in accordance with this invention, by a cultivator which comprises a frame adapted to be moved forwardly over the ground and a plurality of separate gangs which are mounted from the frame for swinging about a transverse axis to rotatably engage spaced-apart rows of crops in a laterally extending row during forward movement of the frame. Each such gang is also swingable about a vertical axis to adjust the angular relation of the path of rotation of the hoes thereof with respect to the rows; and means are carried by the frame for turning the ground intermediate adjacent rows of crops and rearwardly of the engagement therewith of the gangs with the crops."

Typical of the claims in suit is Claim Twenty which reads:

> "20. A cultivator, comprising a frame adapted to be moved forwardly over the ground, a gang of rotary hoes mounted on the frame for swinging about a transverse axis to rotatably engage a row of crops during forward movement of the frame, a pair of additional gangs of rotary hoes each mounted from the frame for swinging about a transverse axis to rotatably engage the ground on each opposite side of the row of crops and rearwardly of the engagement of the hoes of the first-mentioned gang therewith during forward movement of the frame, and means for ad-

justing the angular relation of the path of the rotation of the hoes of each gang with respect to the forward movement of the frame."

A rotary hoe in farm machinery parlance can be likened to a metal wheel (usually about ten to fifteen inches in diameter) from which the rim has been removed leaving the spokes to engage and till the soil as the rotary hoe moves over the ground. The name probably derives from the fact that in earlier models the ends of the spokes were shaped like small hoes which enabled them to engage the ground with a digging action. In more recent versions the spokes have been arcuate in form and their leading edges have been sharpened so that they engage the ground with a slicing action. These are called "slicer tines", but they still fit within the generic term of rotary hoe.[2]

When more than one rotary hoe is mounted on the same axle it is called a "gang of rotary hoes."

Since the parties agree that all of the elements required by the patent in suit were old in the art at the time of its orginal issue, we are concerned here with a combination patent, and the principal issue on the question of validity is whether or not the manner in which the Lehman brothers arranged these elements and provided for their adjustment constituted patentable invention. The problems which the inventors were seeking to solve were stated in the opening paragraphs of the patent as follows:

> "In a conventional rotary cultivator, rotary hoes are fixedly secured across the width of a frame in multiple rows so that, as the frame is moved forwardly, the ends of the legs of each hoe successively penetrate the ground to break up its upper crust. If, however, the ground is not level, the crops from the high rows may be pulled up due to the concentrated weight of the hoes imposed upon them, while the low rows may not even be touched by the hoes.

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[2] Jack C. Whitesides, formerly a design engineer of Lilliston and now a Kelley Vice-President, holds U. S. Patent No. 3,232,356 which covers a slicer tine tool, but the title of the patent is "Rotary Hoe".

Still further difficulty is encountered when the crops to be cultivated are planted either high on a row or deep in a row.

"Ordinarily, weeds are rooted only in the surface crust of the ground above the more deep-rooted crops such that they may be pulled up by the rotary hoes without damage to the crops themselves. When the crops are high, it is desirable to kill off the chopped weeds by covering them with dirt from between the rows. It may also be desirable to build up the row in order to facilitate operation of a mechanical picker or the like. On the other hand, when the crops are low, caution should be taken to see that they are not covered by dirt from between the rows."

To solve these problems the inventors experimented with running a gang of rotary hoes directly over the crop row but angled so as to displace the soil laterally instead of following the row straight on as had previous rotary hoe arrangements. This angled gang (called the "row gang") was followed by two gangs of rotary hoes, one on each side of the row (called "rear gangs") each of which was equipped with means to angle it so as to allow soil to be thrown toward or away from the row. In addition to being thus pivotable about a vertical axis the row gang and the rear gangs were each individually mounted to pivot about a transverse axis which enabled them to be "free-floating" and thus to follow more closely the contour of the row being cultivated. Finally, means were provided for tilting the gangs with respect to the vertical plane.[3] This triangular arrangement of the rotary

[3] Also stressed in the description of the invention was the feature of pivotally mounting the gangs from the frame "for swinging about an axis rearwardly of the engagement of the hoes of such gang with the ground." This arrangement, it was asserted, enabled the hoes to engage the ground with a "pushing" action which resulted in penetration of the ground with "a greater force than the conventional 'pulled' type of hoes." Witnesses at the trial did not ascribe any particular virtue to this feature.

hoes could, of course, be repeated several times on one supporting frame thus allowing several rows to be cultivated at once.

Surprisingly, when this arrangement of angularly-adjustable, free-floating rotary hoes was run over a row of crops it was found that the soil could be cultivated across the top of the row between the plants as well as alongside them, whereas the more conventional arrangements had permitted cultivation only alongside the plants leaving an uncultivated strip along the top of the row. Moreover, it was found that damage to the crops themselves was far less than anticipated, and was in fact quite acceptable. Since this happy result eliminated much of the hand hoeing which had previously been necessary where conventional cultivators were used, it came to be called "once-over, all-over" cultivation.[4]

VALIDITY

Of the multiple charges of invalidity mounted by plaintiff against the '371 reissue patent the court deems the following worthy of discussion.

1. *Prior Use, Sale and Disclosure.*

The Lehmans began work on their invention as early as 1956, and they filed two applications for patents on April 1, 1958. They next filed a continuation-in-part application on March 18, 1959, which included the subject matter of the two prior applications and introduced new matter. On September 7, 1960 a fourth application was filed, and on June 12, 1961 the final application was filed which combined the 1959 and 1960 applications into a single application which matured into the original patent in suit, No. 2,994,387.

The Lehmans sold a cultivator embodying features covered by this patent to a Mr. Eugene Engels "around the

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[4] The term is not used in the patent itself, but the words "once-over" were used in the course of the prosecution of the patent and appear at pages 51 *et seq.* of the file wrapper.

first of March" of 1958. Thus it may very well be that there was a sale of the patented invention more than one year prior to March 18, 1959, the date of the first application referred to in the '387 patent. If so, the patent would be invalid under 35 U.S.C. § 102(b).[5] During the pendency of this action, however, Lilliston applied for and obtained reissuance of the '387 patent as the '271 reissue patent in order to incorporate the filing date of the first Lehman application, that is, April 1, 1958.[6] Since the only evidence of a prior use, sale or disclosure showed it to have been well within one year prior to April 1, 1958, the prior sale charge has not been sustained.

2. *Anticipation by the Prior Art.*

In an infringement suit brought by Lilliston in the Southern District of Texas shortly after the issuance of the '387 patent Judge Reynaldo Garza held the patent valid and in the course of his opinion wrote:

> "There is no question that the patent in suit involves an invention which has been made in a very highly developed and crowded field. The defendant cited more than 80 prior art patents and publications, but at the trial relied mainly upon the Bonds Patent No. 1,249,008, issued in 1917." *Lilliston Implement Company* v. *E. L. Caldwell & Sons, Inc.,* 212 F.Supp. 413, 419 (S.D.Tex. 1962).

While conceding that no claim of the patent in suit is fully anticipated by any single prior art cultivator, the

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[5] The matter is discussed in more detail in *Kelley* v. *Lilliston,* ..... F.Supp. ....., 180 USPQ 364 (E.D.N.C. 1973), in which this court denied plaintiff's motion for summary judgment based on nine separate grounds which included the "on-sale" charge.

[6] In accordance with procedure then in effect this earliest date had not been brought forward in the prosecution as a continuation-in-part of the '387 patent. The only effect of the reissuance was to give the '387 patent the earlier effective date.

plaintiff here has cited over 300 references against the patent and has strongly maintained that when the claims are given the "broad interpretation" contended for by Lilliston they "read on" one or more prior art cultivators. Of the many references cited plaintiff places principal reliance on these twelve patents:

Braun 1,908,110 (PX 10-91)
Remy French 1,104,111 (PX 12-115 and PX 13-116)
Walker 2,227,772 (PX 27-112)
Burns 2,243,241 (PX 55-233)
Ogden 675,968 (PX 11-87)
Maul 529,457 (PX 14-143)
Charley 2,655,083 (PX 41-326)
Newton 1,681,464 (PX 39-325)
Friend 2,579,561 (PX 40-324)
Benjamin 1,760,336 (PX 33-95)
Christensen, et al. 1,043,202 (PX 49-140)
Christofferson 949,218 (PX 48-89)

An examination of these patents reveals that while they all contain one or more of the elements which admittedly were old in the art in 1958(discs, rotary hoes, scratcher teeth, shovels, sweeps, etc.) and means to angle, tilt and "free-float" them, none of them discloses the triangular arrangement of angularly-adjustable, free-floating rotary hoes of the Lehman patent designed to run over a row of crops and cultivate the soil around and adjacent to the plants.

> "It is suggested . . . that [the patent in suit] is nothing more than an aggregation of elements old in the art and as such it comes within the rules of *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147. Of course, to establish anticipation in such a situation, it is not necessary that all of the elements be found in a single patent or publication. It is enough if the whole of the prior art considered together discloses all of the claimed elements and that no new functional relationship arises from their combination. . . . In order to anticipate a patent for a combination, the prior

art must disclose all of the elements of such combination or their mechanical equivalents, functioning in substantially the same way to produce substantially the same result. . . . Rudimentary or unsuccessful experiments with isolated elements of a combination do not anticipate an invention which successfully combines those elements. . . . And, '* * * whoever finally perfects and improves a device and renders it capable of practical, useful and effective operation is entitled to a patent although others had the idea and made experiments toward putting it into practice.* * *'. . . ." (Citations omitted.) *McCullough Tool Company* v. *Well Surveys, Inc.*, 343 F.2d 381. 398-99 (10th Cir. 1965), *cert denied*, 383 U.S. 933 (1966).

Application of these principles to the case at bar has led to the conclusion that the '371 reissue patent is not anticipated by the prior art. While the whole of the prior art considered together discloses all of the claimed elements, the prior art does not disclose all of the elements or their mechanical equivalents functioning in substantially the same way to produce substantially the same result as the patent in suit.

3. *Obviousness.*

35 U.S.C. § 103 provides in pertinent part that:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. . . ."

Application of the statute requires considerations of (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art at the time the invention was made. *Graham* v. *John Deere Company* [sic], 383 U.S. 1, 17 (1966).

(a). *Scope and Content of the Prior Art.*

As previously indicated, the field of mechanical implements for cultivating growing crops and tilling the soil is a very highly developed and crowded one. At the time of the invention in suit it included all cultivating and tillage equipment such as rotary hoes, discs, shovels, sweeps and scratcher teeth, means for disposing, arranging and moving the same over the ground and means for adjusting the same with reference to the horizontal and vertical planes. Not surprisingly, therefore, the parties here have readily agreed that the implements employed in the Lehman patent introduced no new element into the art.

(b). *Differences Between the Prior Art and the Claims at Issue.*

As early as 1894 a patent was issued (Maul No. 529,-457) on a cultivator having two gangs of free-floating "spading teeth" designed to run on opposite sides of a row of crops, but a front/rear rotary tool arrangement was not disclosed. U.S. Patent No. 675,968 issued to Ogden in 1901 disclosed a machine which could be converted from a cotton chopper into a cultivator. Free-floating, cylindrical drums with protruding cultivating teeth served as rotary hoes which were angularly adjustable. As an optional feature a "lister attachment" carrying a "plurality of teeth or shovels" for banking the soil on either side of the row could be mounted rearwardly of the "toothed cylinders". The patent did not disclose means for angling these rear gangs of shovels. In 1939 U.S. Patent No. 2,227,772 was issued to Walker on a cultivator which disclosed rotatable gangs of staggered, sharp-edged blades designed to travel on opposite sides of the row close to the plants. Rearward of these rotary blades shovels were mounted on the same beams which were pivotally attached to the frame forward of the blades. The patent did not disclose an arrangement for allowing the blades to cultivate across the top of the row.

Patents had been issued on numerous other cultivators prior to 1958, but the foregoing are representative of

those cited by the plaintiff in support of its charge of obviousness. From all the cited prior art the court has concluded that the principal difference between the prior art and the claims in issue here (Claims 8, 10-13, and 20-24) lies in the fact that in no prior cultivator had there been an arrangement of a row gang of rotary hoes and two rear gangs of rotary hoes, each separately mounted and free-floating and each angularly adjustable so as to permit "rotatable engagement" of the row of crops with maximum destruction of weeds and grasses and minimal damage to the crops themselves.

(c). *The Level of Ordinary Skill in the Art.*

It was suggested by Judge Garza in the *Caldwell* decision that the ordinary farmer would be a person of ordinary skill in the art of farm machinery design and construction. While numerous patents have issued to farmers (including the Lehmans in this case) on such machinery, ordinarily the level of skill in the mechanical arts is that of persons engaged in the design and manufacture of machinery rather than that of its users. Here the plaintiff contends that a person of ordinary skill in the art has at least the skill of a graduate agricultural engineer.[7] The court would not go so far, but the evidence does support the finding that the level of skill in the art was reasonably high. Many people were at work in this field which, as noted before, had become highly developed and crowded. Even so, no one had put together this combination of old elements in the manner and configuration which gave the much desired results previously mentioned.

The conclusion is that although the scope and content of the prior art encompassed all the elements found in the patent in suit, there are significant differences between

[7] Significantly, plaintiff's expert, Dr. Stanley J. Clark, himself a graduate agricultural engineer, who had been employed by the John Deere Company, was not asked by plaintiff if the patent in suit would have been obvious to him prior to 1958.

the prior art and the claims at issue here and that notwithstanding the level of ordinary skill in the art was reasonably high, the Lehmans were the first to combine the old elements in a way that produced a new, beneficial and unexpected result. It follows that the invention is not void for obviousness.

Adding weight to this conclusion are the so-called secondary considerations, all supported by evidence in this case, of long-felt need for a machine that would eliminate or minimize hand-hoeing; the large number of people who were working on the problem; the fact that most of the elements finally combined by the Lehmans had been known in the art for over fifty years; the skepticism exhibited by many as to whether the invention would work; copying of the invention by established farm machinery manufacturers; the immediate acquisition by Lilliston of the patent rights for a substantial consideration followed by the payment of substantial royalties to the inventors; and the considerable commercial success which Lilliston has experienced in marketing equipment embodying the patented features.[8]

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[8] There is a growing body of opinion that these secondary considerations shoud actually be regarded as of primary importance in determining obviousness under Section 103. *See Reeves Instrument Corporation* v. *Beckman Instruments, Inc.,* 444 F.2d 263 (9th Cir. 1971), and "Laying the Ghost of the 'Invention' Requirement" by the Honorable Giles A. Rich, Associate Judge of the United States Court of Customs and Patent Appeals, a speech given to the Los Angeles Patent Law Association on September 18, 1972. Adoption of these views would certainly alleviate some of the difficulty experienced by the courts in applying what Judge Learned Hand described as "perhaps the most baffling concept in the whole catalog of judicial efforts. . . ." *Lyon* v. *Bausch & Lomb Optical Company,* 224 F.2d 530, 536 (2nd Cir. 1955).

4. *Failure to Clearly Define or Distinctly Claim the Invention.*[9]

Finally, plaintiff strenuously argues that the claims at issue do not particularly point out and distinctly claim the subject matter of the invention as required by 35 U.S.C. § 112. Central to plaintiff's arguments is the contention that the inventive concept claimed by defendant for the invention, namely, that the "cooperative effect" between the combination of the row gangs of rotary hoes and the rear gangs embodied in the claims at issue produces an unusual and unexpected "once-over, all-over" cultivation result, is nowhere spelled out in the patent which is totally lacking in instruction as to exactly how the elements should be arranged to achieve this "cooperative effect".[10] From this factually indisputable premise

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[9] Another position advanced by plaintiff in the pleadings and pre-trial proceedings was the alleged failure of the patent's specification to disclose the manner and process of making the invention in such full, clear, concise and exact terms as to enable persons skilled in the art to make and use the same as required by 35 U.S.C. § 112, but this issue was determined against the plaintiff on its summary judgment motion, *Kelley Manufacturing Company* v. *Lilliston Corporation, supra,* and has not been brought forward in plaintiff's post-trial brief.

[10] The court is under the impression that Lilliston's emphasis on "cooperative effect" may bear a closer relationship to the perceived necessity of demonstrating a "synergistic" result in the light of *Sakraida* v. *Ag Pro, Inc.*, 425 U.S. 273 (1976), and *Anderson's-Black Rock* v. *Pavement Salvage Company,* 396 U.S. 57 (1969), than to anything the Lehmans had in mind as they were working on their invention. The fact remains, however, that the arrangement of the admittedly old elements finally arrived at by them and disclosed in the claims in issue did produce a new, long-sought and beneficial result. That they may not have understood precisely the principles underlying the invention is not fatal to the patent.

> "A patentee may be baldly empirical, seeing nothing beyond his experiments and the result; yet if he has

plaintiff goes on to argue that since the patent does not teach how others may avoid infringing it, it does not satisfy the definiteness requirements of Section 112, citing *General Electric Company* v. *Wabash Appliance Corporation,* 304 U.S. 364 (1938), and *United Carbon Company* v. *Binney & Smith Company,* 317 U.S. 228 (1942).[11]

While it is true that specific directions are not given for the adjustment of the elements to fit all conditions, the claims in issue do disclose in general terms arrangements of the row gangs and rear gangs which enable them to achieve a cooperative effect when properly adjusted for crop and soil conditions, and the evidence establishes to the court's satisfaction that this effect does take place. As the row gang cultivates over the row and removes dirt from around and between the plants it is immediately replaced by dirt thrown toward the row by the rear gangs. This may not rescue as many dislodged plants from "impending death" by restoring them to an upright

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[10] (Continued)

> added a new and valuable article to the world's utilities he is entitled to the rank and protection of an inventor. And how can it take from his merit that he may not know all the forces which he has brought into operation? It is certainly not necessary that he understand or be able to state the scientific principles underlying his invention, and it is immaterial whether he can stand a successful examination as to the speculative ideas involved." *Diamond Rubber Company* v. *Consolidated Rubber Tire Company,* 220 U.S. 428, 435-36 (1911).

[11] Plaintiff also argues that the terms "rotary hoe" and "rotatably engage" are not properly defined in the patent, but the court finds that these terms were widely used and understood in the art. As previously noted "rotary hoe" was understood to include a variety of tools and was used by Mr. Whitesides, now a Kelley Vice-President, to label his invention of a "slicer tine". Whitesides also used the term "rotatably engaging" in a patent issued to him on the Kelley cultivator in 1974. PX 10-100, Columns 4, 5 and 6, Claims 1, 2, 3, 5 and 8.

position as one of defendant's witnesses would have us believe, but it provides a highly effective method of weed and grass control while mulching and aerating the soil with minimal damage to the crops, the results in which farmers are most interested. The fact that the farmer himself must experiment and make adjustments to fit particular conditions does not invalidate the patent for indefiniteness. *Procter & Gamble Manufacturing Company* v. *Refining, Inc.*, 135 F.2d 900 (4th Cir. 1943).

Plaintiff's contention that the patent does not teach how one can avoid infringing it is perhaps best answered in this exchange between counsel for plaintiff and defendant's expert witness:

> Q. If I as a non-Lilliston person, but interested in the art of cultivation, and looking with a view toward developing a cultivator of my own, were to examine U. S. Reissue Patent No. 28,271 . . . where would I find language sufficiently clear that I could determine how to build a cultivator that did not have what you characterized as the "inter-reaction" between front and rear gangs?
>
> A. I am not sure you would find language specifically dealing with that. The purpose of a patent is to tell you what you build to be within the patent. That is, the purpose of the patent is to define the invention and to claim the invention. That is clearly defined in the patent. If you understood that, then there are many things around the periphery that you could build avoiding the patent. The patent's purpose is not to say you can build this and not infringe; you can build that and not infringe; you can build something else and not infringe. The purpose of the patent is to define the metes and bounds of what is within the patent, not to tell you what you can build and not build within the patent (Tr. 9, pp. 1753-55).

The cases cited by plaintiff, *General Electric* and *United Carbon, supra,* are distinguishable and are not regarded as controlling here.

In summary the court is of opinion that Kelley has not carried its heavy burden of establishing by preponderance of the evidence its charges of invalidity based on prior use, sale and disclosure, anticipation by the prior art, obviousness and failure to clearly define or distinctly claim the invention. The court is strengthened in this conclusion by the fact that the Patent Office has twice found the invention patentable (*see Tights, Inc.* v. *Acme-McCrary Corporation,* 541 F.2d 1047, 1051 (4th Cir. 1976)); the fact that in the only court test of the patent in suit which went to final judgment the patent was held valid, *Lilliston Implement Company* v. *Caldwell, supra;* and the fact that two major farm implement manufacturers, John Deere Company and International Harvester, settled infringement actions brought against them by Lilliston and agreed to cease manufacturing their allegedly infringing machinery. PX 42 and 43. It follows that Claims 8, 10 - 13, and 20 - 24 of the '271 reissue patent are valid. The court has carefully considered plaintiff's other charges of invalidity, some of which were previously disposed of in the rulings made on plaintiff's motion for summary judgment previously referred to, but none has been found supported by evidence considered adequate to change this result.

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In addition to the facts found by the court on the issue of validity the court adopts as its own the following proposed findings of fact and conclusions submitted post-trial by the defendant on this issue: Nos. 4.01 - 4.07 inclusive; Nos. 5.10 - 5.14 inclusive; Nos. 6.01 - 6.09 inclusive; Nos. 9.01 - 9.04 inclusive; Nos. 12.02, 12.03, 12.05 - 12.10 inclusive; Nos. 12.17 - 12.23 inclusive; Nos. 12.25, 12.34 and 13.01 - 13.12 inclusive.

INFRINGEMENT

In its counterclaim for infringement Lilliston alleges that Kelley's 400 Series KMC Cultivator contains each of the elements in the '271 reissue patent and that they are normally arranged to produce the identical once-over, all-over cultivation result achieved by the patented invention. In denying infringement Kelley conceded that its cultivator may bear some resemblance to the cultivator now being made and sold by Lilliston, but it denies that Lilliston's present cultivator embodies the patented invention and alleges many distinguishing features between its cultivator and the one actually disclosed in the patent. To obviate this argument the court will disregard the current version of the Lilliston cultivator and will refer to a diagram (Figure 1 below) of the Lehman cultivator as shown (substantially) in the patent and a diagram (Figure 2) of the Kelley cultivator as made and sold today.

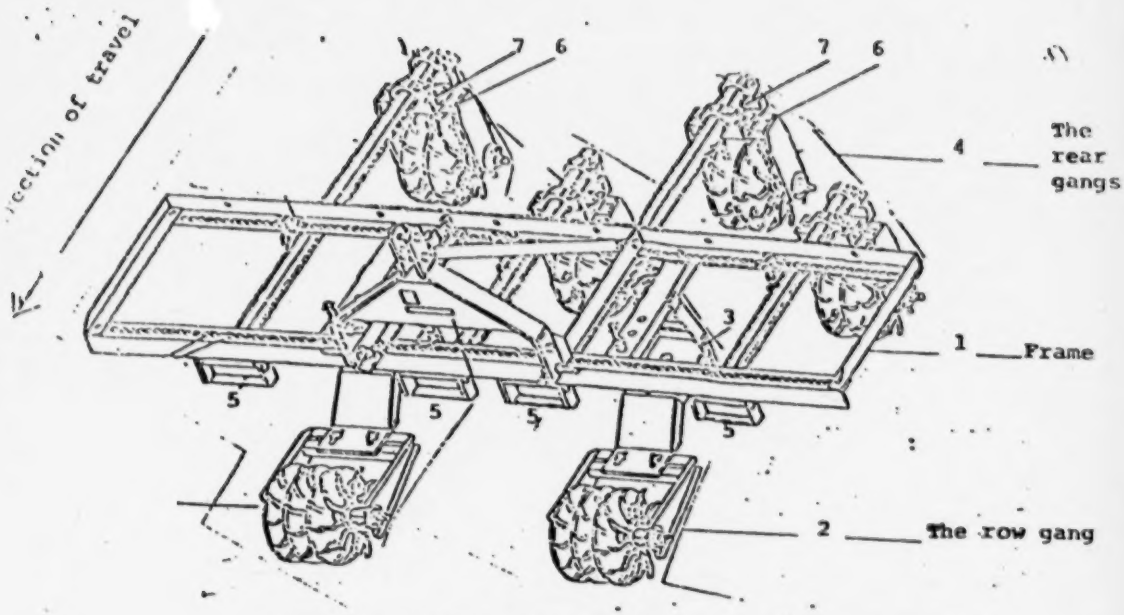

Figure 1. The Lehman Cultivator (two row sections)

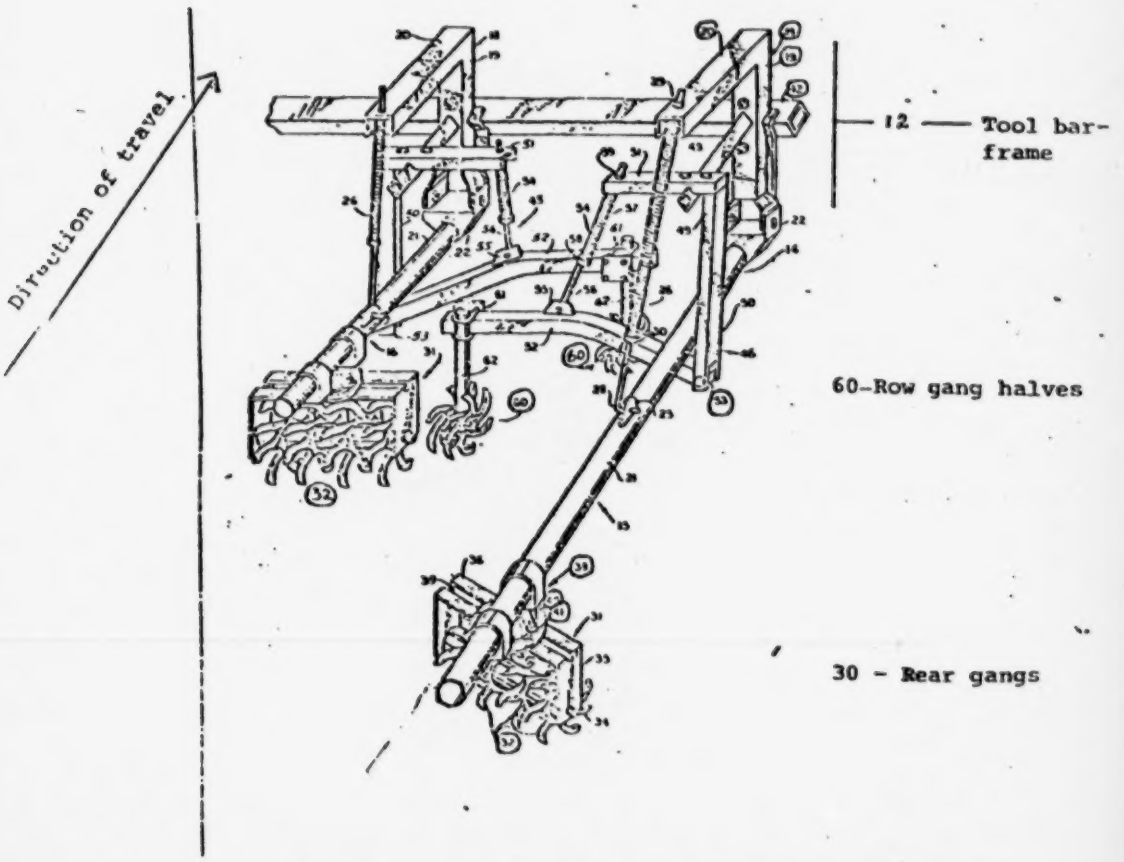

Figure 2. The Kelley Cultivator (one row section)

Claims 8, 10-13 and 20-24 of the patent in suit alleged by Kelley to be invalid are alleged by Lilliston to be infringed. As stated before, Claim 20 is representative of these claims, and we begin by comparing its embodiment in the original Lehman cultivator as shown in Figure 1 with the features of the Kelley cultivator as shown in Figure 2. In the language of Claim 20 the Lehman machine shows:

> A cultivator, comprising
>
> A frame (1) adapted to be moved forwardly over the ground,
>
> A gang of rotary hoes (2),
>
> Mounted on the frame for swinging about a transverse axis (3) to rotatably engage a row of crops during forward movement of the frame,
>
> A pair of additional gangs of rotary hoes (4),
>
> Each mounted from the frame for swinging about a transverse axis (5) to rotatably engage the ground on each opposite side of the row of crops and rearwardly of the engagement of the hoes of the first mentioned gang therewith during forward movement of the frame, and
>
> Means (6) for adjusting the angular relation of the path of rotation of the hoes of each gang with respect to the forward movement of the frame.

Claim 21 which is dependent on Claim 20 only adds

> Means (7) for adjusting and fixing the angular relation of each gang of said pair of gangs with respect to the ground level between positions tilted from one side to the other of a level position.

The Kelley cultivator in Figure 2 by comparison shows (again in Claim 20's language except where shown in brackets):

> A cultivator, comprising
>
> A frame (12), (18), (19), (20) adapted to be moved forwardly over the ground,

A [two-half] gang[s] of rotary hoes (60),

[Each] mounted on the frame for swinging about a [longitudinal] axis (53) to rotatably engage a row of crops during forward movement of the frame,

A pair of additional gangs of rotary hoes (32),

Each mounted from the frame for swinging about a transverse axis (22) to rotatably engage the ground on each opposite side of the row of crops and rearwardly of the engagement of the hoes of the first-mentioned gang therewith during forward movement of the frame, and

Means (40), (41) for adjusting the angular relation of the path of rotation of the hoes of each gang with respect to the forward movement of the frame.

And continuing the comparison with Claim 21 of the patent the Kelley cultivator also shows:

Means (38) for adjusting and fixing the angular relation of each gang of said pair of gangs with respect to the ground level and between positions titled from one side to the other of a level position.

It is readily apparent from the foregoing comparisons that with respect to the rear gangs of rotary hoes on the two cultivators Claims 20 and 21 of the patent in suit read directly on the Kelley cultivator, and the court has no hesitance in so holding.[12] The inquiries before the court are thus narrowed to two:

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[12] Plaintiff makes the point that the slicer tine-type rotary tools used in the Kelley cultivator differ materially from the earlier type rotary hoe disclosed in the '271 reissue patent, not only in form but in the result it achieves, and that this serves to avoid infringement. As has been seen, however, the slicer tine tools classify as rotary hoes, and given the virtually unlimited adjustments available for the rotary hoes on these machines, the court is not persuaded that there is any substantial difference in the results achievable by the various types of rotary tools that may be employed.

1. Does the row gang of the Kelley cultivator which consists of two half gangs suspended from two separate arms each mounted to swing about a "longitudinal" axis, that is, one parallel to the machine's direction of travel, equate with the single row gang of the Lehman cultivator operating off one axle and mounted to swing about a transverse axis, that is, one perpendicular to the direction of travel?

2. If so, is the Kelley cultivator designed to and does it achieve the same once-over, all-over cultivation result as the cultivators built in accordance with the patent in suit?

Lilliston confidently asserts that each of these questions should be answered in the affirmative and that the patent should therefore be held infringed. Kelley, on the other hand, insists that the patent requires a single front gang of rotary hoes mounted "for swinging about a transverse axis to cultivate the soil between the plants along the drill of a row of crops with a non-destructive combing action" and that the Kelley cultivator not only lacks such an element but that it is "not for the purpose of performing, and cannot perform the particular method of cultivating disclosed in the patents." The Kelley cultivators, so the argument goes, are simply "for the purpose of performing a conventional method of cultivating unlike that performed by the invention claimed by the patents in suit."[13]

The court has concluded that in addition to the identity of the rear gang elements of the two machines and the common purpose they serve, the row gang elements in the Kelley cultivator are substantially and functionally equivalent to the row gang of the Lehman cultivator, and when the Kelley cultivator with its triangular arrange-

[13] Implicit in this argument is the suggestion that the Lehman cultivators do indeed produce a result different from that achieved by conventional cultivators, a proposition which plaintiff spent much trial time and not a little briefing trying to refute.

ment of angularly-adjustable, free-floating rotary hoes is run over a row of crops, it is capable of practicing and does in fact practice the invention embodied in the claims in issue.

There is nothing in the patent which limits the row gang to a single gang mounted on one axle, and the fact that the patent drawings do not show a split front gang or other possible arrangements of the elements that might be infringing does not avoid infringement.[14] *Straussler* v. *United States,* 154 Ct. Cl. 275, 290 F.2d 827 (1961).

Although the matter of the mounting of the Lehman row gang on a transverse axis vis-a-vis the Kelley row gang's mounting on a longitudinal axis was debated at length during the trial and in the briefs, the court is not persuaded that the difference between the two mountings is a material one. The object of allowing the gangs to swing about any axis is simply to allow them to "float" freely and follow the contour of the ground in order to achieve closer cultivation of the entire surface.[15]

The question of whether the Kelley cultivator is designed to and does in fact achieve the same once-over, all-over cultivation result as cultivators built in accordance with the patent in suit must also be answered in the affirmative. This conclusion follows from the close sim-

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[14] In 1962 Lilliston began using the split row gang on its cultivators and mounting them on a parallel linkage device patented by Mr. Whitesides (DX 11-71, U.S. Patent No. 3,203,487), who was then with Lilliston. The split gangs continued to "free-float" together on a transverse axis and to remain laterally adjustable so as to achieve "rotatable engagement" with the row crops.

[15] It is true, as plaintiff's expert, Dr. Stanley Clark, testified, that this mounting of the Kelley row gangs causes them to describe arcs in the vertical plane which action may in turn bring the rotary hoes slightly closer to or slightly further away from the plants as they go up and down with the contour of the row, but the court is convinced that the effect of this, if any, on the cultivating result is minimal.

ilarity between the manner in which the Kelley cultivator is advertised to operate, from the testimony of witnesses who have observed and compared the operation of the cultivators in the fields and from the movies of these operations as shown by Lilliston during the trial.[16]

To begin with, the Kelley cultivator is built in accordance with U.S. Patent No. 3,794,123 (DX 10-100) issued to Jack C. Whitesides after he left Lilliston and joined Kelley. The diagram shown in Figure 2, *supra,* is adapted from the diagram shown in that patent. The Whitesides invention is summarized in the patent as follows:

> "Briefly described, the present invention comprises a cultivator which utilizes a plurality of independently suspended rotary hoe gangs to till the soil along a plurality of crop rows. The rotary hoe gangs are mounted on a framework and are adjustable with respect to the framework so that the gangs of rotary hoes can be positioned in various different arrangements, including arrangements where virtually all of the soil along a crop row can be tilled without leaving any untilled portions. The cultivator has its rotary hoe gangs arranged in groups for each crop row, with each group including one pair of rotary hoe gangs each being swingable about an axis normally extending along the crop row, and a second pair of rotary hoe gangs each being swingable about an axis extending normally transverse to the crop row. The first pair of rotary hoe gangs are each mounted on a laterally extending support leg which extends across the crop row from its respective rotary hoe gang, and the rotary hoe gang of each laterally extending support leg can be positioned along the length of its support leg in overlapping or spaced relationship

[16] Kelley's expert, Dr. Clark, gave testimony to the contrary, but the experiments which he described appear to have been controlled and did not include several of the experiments performed by defendant's experts. Significantly, Kelley brought no movies to the trial to illustrate the testimony of its witnesses.

with respect to the other rotary hoe gangs of the group in various lateral positions along the crop row to be tilled by the group of rotary hoes." (Col. 1, Lines 37-60)

Claim 1 of the Whitesides patent reads:

"A cultivator comprising a framework for towing by a tractor or the like in a forward direction over the ground along crop rows, a first gang of rotary hoes mounted on said framework for rotatably engaging a crop row closely adjacent the crop in the crop row and arranged to swing with respect to said framework about an axis extending normally approximately parallel to the direction of forward movement of said framework and laterally displaced from the first gang of rotary hoes across the crop row, and a second gang of rotary hoes mounted on said framework for rotatably engaging a crop row further away from the crop in the crop row than said first gang and arranged to swing with respect to said framework about an axis extending transverse to the direction of forward movement of said framework." (Col. 4, Lines 52-67)

Other claims in the patent are similar, and it is perfectly apparent to the court that Whitesides was making a conscious effort to patent a cultivator that would do everything the Lilliston cultivator would do and at the same time, it is assumed, he wished to avoid infringement of the Lehman patent if possible.[17]

". . . If the inventive idea of the original patentee has been appropriated, and the alleged infringing device contains the material features of the patent in suit, the court will declare infringement, even when those features have been supplemented or modified to such an extent that the defendant may be en-

[17] No presumption that the Kelley cultivator does not infringe arises from the fact that Whitesides was issued a patent on the independent suspension for the row gang halves which is claimed to be an improvement over the suspension systems disclosed in the '271 reissue patent.

titled to a patent for the improvement." *Crown Cork & Seal Company* v. *Aluminum Stopper Company*, 108 F. 845, 866 (4th Cir. 1901)

The close similarity between the operation of the Kelley cultivator and cultivators built in accordance with the patent claims in suit is further graphically illustrated by a comparison of the assembly instructions of the Kelley Owners Manual (DX 91-73, p. 6) with the assembly instructions of the Lilliston Owners Manual (DX 139-175, p. C). Diagrams from the two manuals are reproduced as Appendix B attached and even a cursory inspection shows the two diagrams to be virtually identical.[18]

Still further evidence of the similarity between the operation of the Kelley cultivator and the cultivators made in accordance with the Lehman patent is to be found elsewhere in the Kelley Owners Manual (DX 91-73 at p. 3) where it is said:

"5. ROW SPIDER GANG ADJUSTMENT

"a. The function of the row gang is to cultivate the soil close to the crop row. Each row gang half can be angled to move soil to the row or away from the row. The spiders should be run as close to the row as possible without harming the crop.

"6. REAR SPIDER GANG ADJUSTMENT

"a. The function of the rear gang is to cultivate the area between crop rows. Gangs can be angled to move soil to the row or away from the row and can be tilted on the pipe to conform to bed shapes.

"7. TYPICAL GANG SETTINGS

"a. The assembly layout drawing shows a typical cultivator setting. Observe that the row gangs are angled to move soil away from the crop row and

[18] It should be noted that the diagram of the Lilliston cultivator in Appendix B is of a later model with a split and staggered row gang rather than the single row gang of the original Lehman cultivator, but the evidence has shown no significant difference between the cultivation results achieved by the two models.

the rear gangs are angled to move soil to the crop row. This particular setting is recommended for larger crops or second cultivation. For small crops or the first cultivation, it is recommended that the row gangs be angled to move soil to the row and the rear gangs angled sufficiently to uproot all weeds as the spiders move soil away from the row."

The deposition testimony of C. J. Whitefield, a mechanical engineer who was formerly Lilliston's senior project engineer and now a Kelley Vice-President, confirms that the Kelley cultivator is claimed by Kelley to do everything the Lilliston machine will do and more.

Q. Did you think the Lilliston rotary cultivator in 1972 was a reasonably effective substitute for a Kelley rotary cultivator?

A. I am sure some Lilliston dealers and customers all felt so, but I would feel ours was a superior machine.

Q. Yours would do everything that the Lilliston machine would do and something more; is that what you are saying?

A. I think that pretty well sums it up. We intended to do more. (Tr. 9, p. 1648)

Finally, defendant's witnesses testified convincingly that the Kelley cultivator and the Lilliston-Lehman machines were functionally equivalent and the motion pictures (DX 30-201) shown by defendant corroborated their testimony.

The conclusion is inescapable that the Kelley cultivator not only contains the same or the functionally equivalent of all the elements disclosed in the '271 reissue patent claims in suit but it is also designed to and does in fact achieve the same once-over, all-over cultivation result as is achieved by cultivators embodying the claims of that patent which are in issue here. *Specialty Equipment & Machinery Corporation* v. *Zell Motor Car Company,* 193 F.2d 515 (4th Cir. 1952). The patent is infringed.

• • •

In addition to the facts found by the court on the issue of infringement the court adopts as its own the following proposed findings of fact and conclusions submitted post-trial by the defendant on this issue: Nos. 7.01-7.08 inclusive: 11.01-11.13 inclusive and 11.16-11.25 inclusive.

The conclusions reached with respect to validity and infringement render moot plaintiff's claim for attorney's fees pursuant to 35 U.S.C. § 285. At this time the court is of the opinion that defendant's motion for attorney's fees should be denied, but this question will be left open until the hearing on the issue of damages at which time evidence may be submitted on the question by both parties.

CONCLUSION

The court's findings of fact and conclusions set forth in this memorandum of decision are summarized as follows:

1. The court has jurisdiction of the parties and subject matter.

2. United States Reissue Patent No. 28,271 is valid and it is infringed by the 400 Series KMC Cultivator manufactured and sold by Kelley Manufacturing Company.

3. Pursuant to Rule 54(b), F.R.Civ.P., the court finds that there is no just reason for delay, and subject to an accounting for the determination of damages due defendant on its counterclaim for infringement final judgment will be entered with respect to the First Claim in the plaintiff's complaint.

/s/ F. T. Dupree, Jr.
F. T. Dupree, Jr.
United States District Judge

June 2, 1978

APPENDIX A —

Objects of the invention

Reissue Patent No. 28,271

An object of this invention is to provide a rotary cultivator having separate gangs of "free-floating" rotary hoes which will engage the row crops with a greater force than heretofore possible with cultivators having conventional free-floating gangs of hoes.

Another object is to provide a rotary cultivator having separate gangs of free-floating rotary hoes which are individually free to conform to the contour of the row each engages.

A further object is to provide a rotary cultivator having separate gangs of free-floating rotary hoes whose ground turning action may be regulated by their angular adjustment with respect to the row crops without a substantial change in their tracking pattern.

Still another object is to provide a rotary cultivator having rotary hoes which will uniformly engage the row crops as well as the ground between the rows regardless of the contour thereof and which will permit the weeds to be pulled from the row crops and covered with dirt turned from between the rows.

A still further object to provide a rotary cultivator of the type above described in which the rotary hoes are mounted with respect to one another in a compact arrangement which, at the same time, enables them to engage the ground with maximum leverage.

Yet another object is to provide such a rotary cultivator which is readily adjustable in a manner to prevent dirt from between the rows being turned onto the crops.

Another object is to provide a cultivator which is readily adjustable for use in cultivating different widths of rows, or even double row crops, as well as in turning a greater or lesser amount of dirt onto the rows.

Still another object is to provide a cultivator in which the cultivating elements thereof are selectively interchangeable with one another to turn dirt from between the rows in either of two directions.

Still a further object is to provide a cultivator having a vehicular frame for supporting the cultivating elements in a manner to permit the force with which such elements engage the ground to be adjusted to a desired amount.

A still further object of this invention is to provide an improved cultivator of the type above described in which the ground intermediate either high or deep planted crops may be turned either toward or away from the crops.

Yet another object is to enable the above-described cultivator to be converted for such use with a minimum of time and expense.

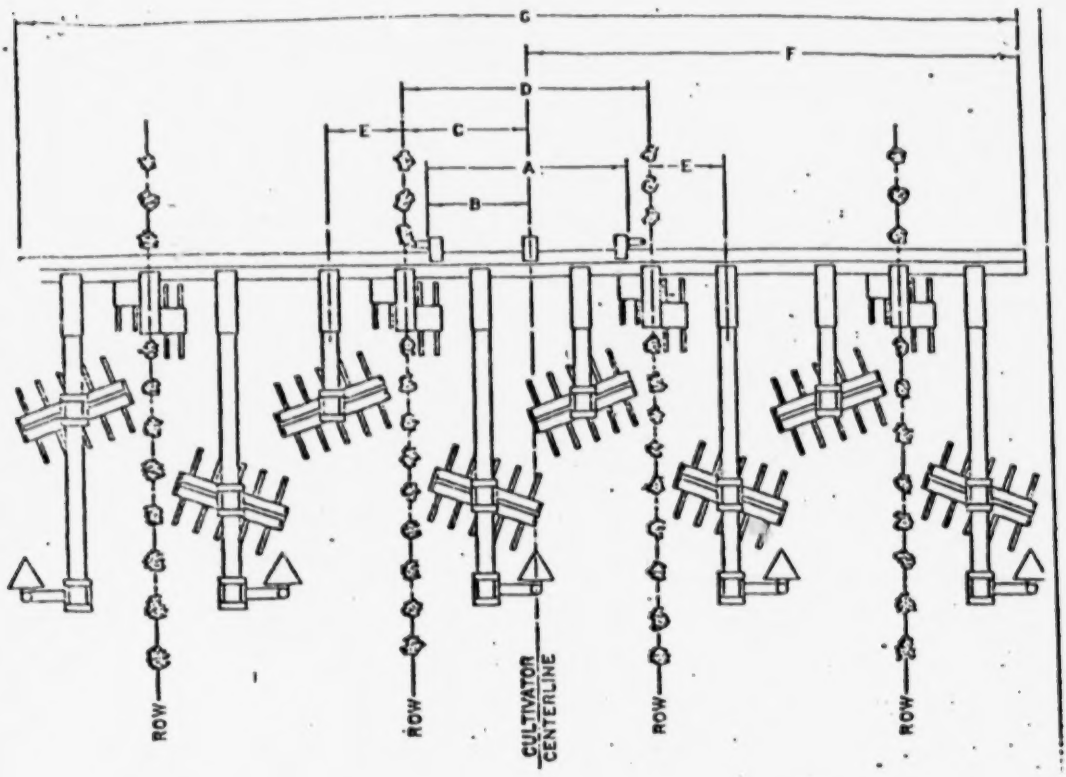
Other objects, advantages and features of this invention will be apparent to one skilled in the art upon a consideration of the written specification, the attached claims and the annexed drawings.

These and other objects are accomplished, in accordance with this invention, by a cultivator which comprises a frame adapted to be moved forwardly over the ground and a plurality of separate gangs which are mounted from the frame for swinging about a transverse axis to rotatably engage spaced-apart rows of crops in a laterally extending row during forward movement of the frame. Each such gang is also swingable about a vertical axis to adjust the angular relation of the path of rotation of the hoes thereof with respect to the rows; and means are carried by the frame for turning the ground intermediate adjacent rows of crops and rearwardly of the engagement therewith of the gangs with the crops.

From the foregoing, it wil be apparent that each gang is free-floating so as to conform to the ground levels of the row crops. It will also be apparent that the an-

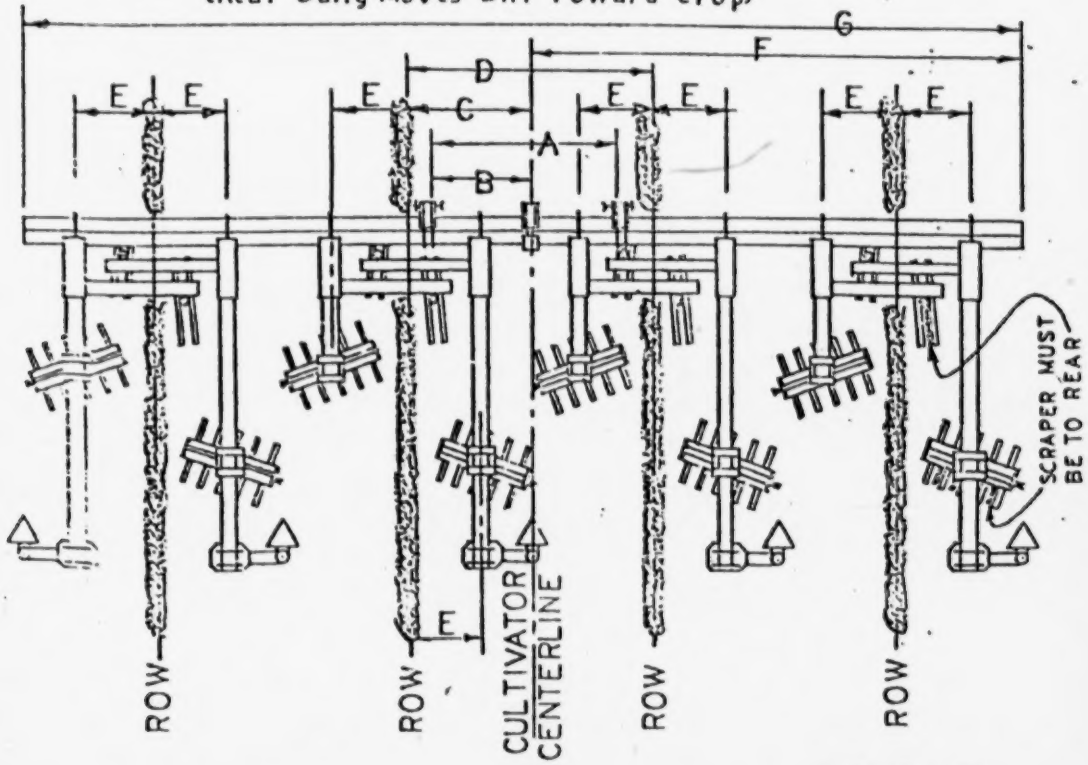
gular adjustment of each gang enables regulation of the extent with which the weeds are chopped out of the crops.

Each separate gang is pivotally mounted from the frame for swinging about an axis rearwardly of the engagement of the hoes of such gang with the ground. In this manner, the hoes engage the ground with a "pushing" action which causes them to penetrate the ground with a greater force than the conventional "pulled" type of hoes. In one form of the invention, the support for each gang of rotary hoes may be pivotally mounted from the frame for swinging about a longitudinal axis so that each gang is free to rock into conformity with the contour of the row it engages.



ASSEMBLY LAYOUT (KELLEY)

For Row Spacings Of 28 Inches And Wider
(Rear Gang Moves Dirt Toward Crop)



APPENDIX B

CIVIL NO. 1295

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF NORTH CAROLINA
WILSON DIVISION

KELLEY MANUFACTURING COMPANY,
Plaintiff,

vs.

LILLISTON CORPORATION,
Defendant.

AMENDED JUDGMENT
(Filed June 9, 1978)

This court, having entered a Judgment on June 2, 1978 and now finding it omitted by inadvertence to have provided injunctive relief requested by defendant in its Counterclaim, hereby enters this Amended Judgment.

For the reasons stated in the court's memorandum of decision filed on June 2, 1978, it is now

ORDERED, ADJUDGED AND DECREED:

1. United States Reissue Patent No. 28,271 is valid.

2. United States Reissue Patent No. 28,271 is infringed by the 400 Series KMC Cultivator manufactured and sold by the plaintiff, Kelley Manufacturing Company.

3. Subject to an accounting to determine damages due defendant on its counterclaim for infringement there is no just reason for delay and this is a final judgment with respect to the First Claim in the plaintiff's complaint and defendant's counterclaim for infringement.

4. A writ of injunction issue out of and under the seal of this court, directed to Kelley Manufacturing Company and its officers, agents, servants, employees, attorneys, and persons in active concert or participation with

it, enjoining and restraining them from directly or indirectly in any manner infringing United States Letters Reissue Patent No. 28,271.

5. Jurisdiction is retained for purposes of the accounting and for trial or other disposition of the remaining four claims in plaintiff's complaint.

/s/ F. T. Dupree, Jr.
F. T. Dupree, Jr.
United States District Judge

Dated: June 9, 1978

UNITED STATES COURT OF APPEALS

For The Fourth Circuit

No. 78-1700

UNPUBLISHED

KELLEY MANUFACTURING COMPANY,

Appellant,

vs.

LILLISTON CORPORATION,

Appellee.

Appeal from the United States District Court for the Eastern District of North Carolina, at Wilson.

FRANKLIN T. DUPREE, *District Judge.*

(Argued December 3, 1979—Decided February 28, 1980)

Before BRYAN, *Senior Circuit Judge,* WIDENER and MURNAGHAN, *Circuit Judges.*

James M. Wetzel (John R. Crossan; R.C. Howison, Jr., Henry S. Manning, Jr., Edward S. Finley, Jr., Joyner & Howison on brief) for Appellant; William A. Marshall (Charles J. Merriam, Nate F. Scarpelli, Merriam, Marshall & Bicknell; Edward Taylor Newton, William J. Ormsby, Jr., William H. Needle, Newton, Hopkins & Ormsby; Cyrus F. Lee, Connor, Lee, Connor, Reece & Bunn on brief) for Appellee.

PER CURIAM:

Appellant Kelley Manufacturing Company instituted this suit in the Federal District Court for Eastern North Carolina, seeking a declaration of invalidity, unenforceability and non-infringement of a patent held by appellee Lilliston Corporation on an apparatus employing gangs of rotary hoes for crop-cultivation. The patentee answered maintaining the patent's validity and counterclaiming for infringement by Kelley. After a jury-waived trial, the Court, in its Memorandum Decision of June 2, 1978, upheld the patent and found it to have been infringed by a machine manufactured and sold by Kelley. Kelley now appeals and we affirm.

The facts as found by the District Judge follow. Charles L. Lehman and Alvin H. Lehman were issued patent No. 2,994,387 (the '387 patent) on August 1, 1961 for a machine entitled "Cultivator" on their application of June 12, 1961. It was assigned to Lilliston Corporation later in 1961. During the pendency of this action, Lilliston became aware that the date of the first Lehman application for a patent relating to the cultivator (April 1, 1958) was not mentioned in the final application of June 12, 1961. Thereupon Lilliston applied for a reissue patent, which was granted as reissue No. 28,271 (the '271 patent), dated February 10, 1974 and incorporating April 1, 1958 as the effective date.

The implement to which the patent relates is a machine used for cultivating crops planted in parallel rows. The parties agree that all of the elements found in this machine were "old in the art" at the time of the patent's issue. Thus, the patent is a "combination patent" the validity of which depends on the inventiveness of the arrangement and adjustment of the old elements. The Kelley Manufacturing Co. began selling its allegedly infringing product in September, 1971.

We see the record as fully supporting the District Court's declaration that the Lilliston patent is valid and its rejection of Kelley's assertions, based on prior sale,

anticipation and obviousness[1], that the patent should not stand. Likewise, we find adequate evidence to justify the District Court's conclusion that, despite some differences in their structures, the crucial elements of the two cultivators are "substantially and functionally equivalent," and that the Kelley cultivator infringes on Lilliston's patent. We therefore affirm the lower court's disposition of both of these issues on the basis of its opinion. *Kelley Manufacturing Co.* v. *Lilliston Corp.*, No. 1295 Civ. (E.D.N.C. June 2, 1978).

Kelley argues strenuously that the District Court failed to address its defense of "intervening rights." Kelley claims that, when it began selling its cultivator in 1971, it did so in "the good faith belief" that it would not be liable for infringement. This belief rested on Kelley's awareness that the technical defect in Lilliston's '387 patent, its failure to adopt the earliest application date, could render the patent invalid because of a sale of the patented machine more than a year before the '387 patent's effective date. The subsequent reissuance of the patent to correct that defect, Kelley contends, should not subject Kelley to liability for the previous marketing of the infringing machine.

A court, in its discretion, may recognize the "intervening rights" of an infringer under the traditional equitable doctrine now codified in Section 252 of Title 35 of the United States Code. The District Court apparently declined to do so here, and we find ample support in the record for this result. Kelley's admitted desire to take advantage of an easily remediable technical error in the

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[1] Kelley correctly points out in this appeal that the District Court's opinion erroneously states that Kelley failed to ask its own expert witness whether the patent would have been obvious to him prior to 1958. A question to that effect was posed and Dr. Clark responded affirmatively. Transcript at 123-24. In view of the ample evidence supporting the Court's finding of nonobviousness, however, this inaccuracy does not undermine the Court's holding.

Lilliston patent cannot be equated with the situation the doctrine obviously contemplates—infringement resulting from good faith reliance on the claims asserted in an earlier patent. *See, e.g., Wayne-Gossard Corp.* v. *Moretz Hosiery Mills, Inc.*, 539 F.2d 986, 989-91 (4th Cir. 1976). *Cf. Grant* v. *Raymond*, 31 U.S. 218, 243-44 (1832) Marshall, C.J.) (discussing policies favoring recognition of priority of reissued patents). At any rate, the doctrine has no application where the crucial claims of the reissued patent are substantially identical to those of the original patent, 35 U.S.C. § 252, as is indeed the case here.[2] Therefore, in affirming the decision of the District Court, we also affirm that court's refusal to confer upon Kelley the benefit of the intervening rights defense.

In fine, the District Judge's Memorandum Decision and his other rulings are comprehensive, exhaustive and sound, and adopting them we render a judgment of affirmance. *Kelley Manufacturing Co.* v. *Lilliston Corp.*, No. 1295 Civ. (E.D.N.C. June 2, 1978).

Affirmed

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[2] Kelley contends that the change in priority date constitutes the requisite change in the claims of the patent to justify its assertion of intervening rights. Although Section 252 could come into play to protect "[t]he equitable interests of any party who might have been misled by a lack of notice of the . . . priority date" later established in the reissued patent, *Fontyn* [sic] v. *Okamoto*, 518 F.2d 610, 623 (C.C.P.A. 1975), the circumstances of this case do not call for the invocation of the doctrine.

UNITED STATES COURT OF APPEALS

FOR THE FOURTH CIRCUIT

No. 78-1700

KELLEY MANUFACTURING COMPANY,

Appellant,

vs.

LILLISTON CORPORATION,

Appellee.

ORDER

(Filed April 28, 1980)

Upon consideration of the appellant's petition for rehearing, by counsel,

IT IS ORDERED that the petition for rehearing is DENIED.

Entered at the direction of Judge Bryan, for a panel consisting of Judge Bryan, Judge Widener, and Judge Murnaghan.

For the Court,

/s/ William K. Slate, II
Clerk

AUTHORITIES CITED

THE CONSTITUTIONAL PROVISION

Art. 1, Sec. 8. The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

STATUTES

TITLE 35, UNITED STATES CODE

§ 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

. . .

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or . . . .

§ 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

§ 120. Benefit of earlier filing date in the United States

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

§ 251. Reissue of defective patents

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the application, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

§ 252. Effect of reissue

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent

that its claims are identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question may provide for the continued manufacture, use or sale of the thing made, purchased or used as specified, or for the manufacture, use or sale of which substantial preparation was made before the grant of the reissue, and it may also provide for the continued practice of any process patented by the reissue, practiced, or for the practice of which substantial preparation was made, prior to the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

§ 254. Certificate of correction of Patent and Trademark Office mistake

Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Commissioner may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Commissioner may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

RULES

TITLE 37 — CODE OF FEDERAL REGULATIONS

§ 1.175 Reissue oath or declaration.

(a) Applicants for reissue, in addition to complying with the requirements of the first sentence of § 1.65, must also file with their applications a statement under oath or declaration as follows:

(1) When the applicant verily believes the original patent to be wholly or partly inoperative or invalid, stating such belief and the reasons why.

(2) When it is claimed that such patent is so inoperative or invalid "by reason of a defective specification or drawing," particularly specifying such defects.

(3) When it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming more or less than he had a right to claim in the patent," distinctly specifying the excess or insufficiency in the claims.

(4) When the applicant is aware of prior art or other information relevant to patentability, not previously considered by the Office, which might cause the examiner to deem the original patent wholly or partly inoperative or invalid, particularly specifying such prior art or other information and requesting that if the examiner so deems, the applicant be permitted to amend the patent and be granted a reissue patent.

(5) Particularly specifying the errors or what might be deemed to be errors relied upon, and how they arose or occurred.

(6) Stating that said errors, if any, arose "without any deceptive intention" on the part of the applicant.

(b) Corroborating affidavits or declarations of others may be filed and the examiner may, in any case, require additional information or affidavits or declarations concerning the application for reissue and its object.

IN THE UNITED STATES PATENT OFFICE

IN RE: Patent No. 2,994,387

GRANTED: August 1, 1961

TO: Charles L. Lehman
and
Alvin H. Lehman

FOR: CULTIVATOR

On Petition for Certificate of Correction

The petition under 35 U.S.C. 254 and Rule 322, filed with the Solicitor on May 23, 1973, has been carefully considered. However, no certificate of the character sought is warranted.

By examiner's amendment dated June 15, 1961, characterization of application S.N. 113,993 (upon which the captioned patent was granted) as a "continuation" of prior applications S.N. 800,304 and 54,468 was changed to "continuation-in-part" thereof. No error is seen in that change, since S.N. 113,993 consolidated the disclosures of the other two and therefore clearly added matter to each taken individually. As defined in §201.08 of M.P.E.P.

> "A continuation-in-part is an application filed during the lifetime of an earlier application by the same applicant, repeating some substantial portion or all of the earlier application *and adding matter not disclosed* in said earlier case."

Since the disclosure presented in a "continuation" must be the same as that of its patent, it would have been misleading to permit characterization of the patent as a "continuation" of either S.N. 800,304 and 54,468. It is noted that the applicants tacitly acceded to the examiner's change, since no countermanding Rule 312 amendment was filed as suggested in the examiner's amendment where "changes are not satisfactory to the applicant." Also,

the particular labeling of an application as a "continuation" or "continuation-in-part" of an earlier application should not be a matter of dire consequence, particularly since those terms do not appear in 35 U.S.C. 120. To secure whatever benefit petitioner is entitled to under §120, where applications S.N. 800,304 and 54,468 are concerned, it would seem sufficient that the patent merely make "specific reference" thereto.

Petitioner recognizes that additions of specific references to the yet earlier applications S.N. 725,640 and 725,641 may be sought by reissue. *Sticker Industrial Supply Corp.* v. *Blaw-Knox Company et al.,* 167 USPQ 442 (DC N.D. Ill., 1970). However, the argument is advanced that the omission of such references in S.N. 113,993 could be likened to a *trivial clerical error,* and hence subject to correction by certificate under 35 U.S.C. 254. *Brenner* v. *The State of Israel,* 158 USPQ 584 (CA DC, 1968) is cited in support of that characterization. While correction by certificate of correction would certainly simplify matters for petitioner and the Patent Office, consideration due others militates against that resolution.

In the *State of Israel* case, the rights of third parties were acknowledged, the court opining that "We think that it is altogether possible that Section 252 can be read broadly enough to protect a deserving third party in this kind of situation" (158 USPQ 586). On the other hand, third parties could not assert any comparable statutory intervening right if correction were obtained by certificate of correction.

Petitioner faults the examiner for not suggesting that reference be made in S.N. 113,993 to S.N. 725,640 and 725,641. However, petitioner will recall that the latter were referred to in S.N. 800,304, and that S.N. 113,993 in turn referred to S.N. 800,304. Also, patent No. 2,994,387 was granted prior to the published decision in *Holvid* v. *Asari,* 134 USPQ 162 (CA 9, 1962). Consequently, there was no apparent need to suggest that petitioner speci-

fically refer to S.N. 725,640 and 725,641 in S.N. 113,993. The examiner may not have been clairvoyant, but cannot reasonably be faulted on that account.

/s/ Jere W. Sears
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[counsel's address omitted]